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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD S. BELLIVEAU

Appeal 2010-007121
Application 10/801,177
Patent 6,357,893 B1
Technology Center 2800

Before: ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*, LINDA E. HORNER and MARC S. HOFF, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Richard S. Belliveau (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's decision in reissue application 10/801,177. This reissue application seeks to reissue U.S. Patent 6,357,893 B1 ("the '893 patent"), issued March 19, 2002, based on Application 09/526,499 ("the '499 application"), filed March 15, 2000.

The Examiner rejected claims 1-82, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

THE INVENTION

Appellant's invention is an apparatus for using a plurality of light sources to illuminate an area or aperture. The '893 patent, col. 1, ll. 5-7. The '893 patent issued with claims 1-12, which correspond to claims 1-12 currently pending in this reissue application on appeal. The '893 patent, col. 19, l. 61 - col. 20, l. 26. The remaining claims 13-82 were added by reissue. Claim 13, reproduced below, is representative of the subject matter of the newly-added reissue claims.

13. A lighting apparatus comprising:

a substrate;

a plurality of light emitting diodes;

a lamp driver circuit;

a communications component;

a first housing in which the substrate is located;

wherein the substrate has a first circuit and a second circuit;

wherein the lamp driver circuit is electrically connected to the first circuit and the second circuit;

wherein a first portion of the plurality of light emitting diodes are connected to the first circuit and the first circuit can vary the intensity of the light emitted by the first portion of the plurality of light emitting diodes;

wherein a second portion of the plurality of light emitting diodes are connected to the second circuit and the second circuit can vary the intensity of the light emitted by the second portion of the plurality of light emitting diodes;

wherein the first portion of the plurality of light emitting diodes emits light of a first color and the second portion of the plurality of light emitting diodes emits light of a second color different from the first color;

wherein the second color is generated by white light emitting diodes; and

wherein the communications component can receive a control command for varying either the intensity of the first portion of the plurality of light emitting diodes or the second portion of the plurality of light emitting diodes to change the color temperature of the light emitted from the plurality of light emitting diodes.

THE REJECTION

Appellant seeks review of the Examiner's rejection of claims 1-82 as based on a defective reissue oath or declaration for lack of error correctable under 35 U.S.C. § 251.

ISSUE

The Examiner determined that claims 13-82 of the reissue application are drawn to non-elected species of the original application.[2] Ans. 6-7. The Examiner states that by failing to file a divisional application during the pendency of the original application, Appellant surrendered the right during reissue of the patent directed to the elected species to claim subject matter other than the elected (and issued) invention. Ans. 8. Based on this reasoning, the Examiner concluded that Appellant failed to state an "error" correctable by reissue under 35 U.S.C. § 251. *Id.*

Appellant argues the Examiner's rejection is in error because independent reissue claims 13, 33, 35, 50, 73, and 79 are substantially different from the non-elected claims that were restricted in the original application. App. Br. 13-25, 27-28, 30, 36-38.

The issue before us is whether reissue claims 13-82 are based on a defective reissue oath or declaration for lack of error correctable under 35 U.S.C. § 251.

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[2] The Examiner rejected claims 1-82, but finds that only claims 13-82 are directed to non-elected species. Ans. 6. Claims 1-12 are directed to the elected species because they correspond to claims 1-12 of the '893 patent. Presumably the Examiner rejected reissue claims 1-12, because in the event that the rejection of claims 13-82 is upheld, then there would be no error being corrected in the remaining claims 1-12. Because we are reversing the rejection of claims 13-82, we likewise reverse the rejection of claims 1-12 under § 251.

FINDINGS OF FACT

We find that the following enumerated facts are supported by at least a preponderance of the evidence.

1. The Examiner determined that the '499 application contained claims directed to four patentably distinct species of the claimed invention, and imposed a four-way election of species requirement with the following groups:

I. Directed to Figures 2A, 2B, 3A-C, and 3F;

II. Directed to Figure 3D;

III. Directed to Figure 3E; and

IV. Directed to Figures 9A and 9B with subspecies in Figures 4A-C, 5A-C, 6A-C, 7A-C, 8A-C, and 12A-C.

Office Action dated April 30, 2001, page 2. The Examiner did not identify in the Office Action which claims were associated with each group. Other than identifying the associated figures, the election of species requirement did not describe the subject matter of each group or explain in what aspects the grouped figures represented distinct species. Office Action dated April 30, 2001, *passim*.

2. Appellant elected group 1, without traverse, but did not identify which of the originally-filed claims corresponded with the figures of the elected group. Response to Election/ Restriction dated May 21, 2001, pages 1-2.

3. On November 15, 2001, the Examiner identified original claims 1-9, 25, 26, and 50 as corresponding to the elected species (group I), and canceled claims 10-24 and 27-49 as being drawn to a non-elected

invention (groups II-IV). Notice of Allowability dated November 15, 2001.

PRINCIPLES OF LAW

Under 35 U.S.C. § 251, reissue is permissible "[w]henever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." Section 251 "is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally." *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986) (citations omitted).

When applicants cancel claims to the non-elected invention in response to the examiner's restriction requirement, and then fail to file a divisional application embodying the canceled claims, the applicants are deemed to have acquiesced to the restriction and are estopped from obtaining by reissue the subject matter of the canceled claims. *See In re Orita*, 550 F.2d 1277, 1280-81 (CCPA 1977) (there is no correctable error in failing to prosecute a divisional application to reissue claims substantially identical to the non-elected claims identified by the examiner in the restriction requirement).

Thus, 35 U.S.C. § 251 prohibits reissue claims that are identical or substantially identical to the non-elected claims.

ANALYSIS

Here, the Examiner made no finding that reissue claims 13-82 of the '177 application are identical or substantially identical to canceled claims 10-24 and 27-49 of the '499 application. Ans. *passim*. Appellant asserts that independent reissue claims 13, 33, 35, 50, 73, 78, and 79 are substantially different from the canceled claims in the original application.[3] App. Br. 13-25, 27-28, 30, 36-37. The Examiner's Response to Argument does not contest this assertion. Ans. 5-10; Reply Br. 2 (noting the failure of the Examiner to address Appellant's assertion).

In addition to the lack of a finding that reissue claims are identical or substantially identical to the canceled claims, the record is unclear as to what Appellant acquiesced in the election of species. The Examiner based the election of species upon figures of Appellant's application, without identifying which claims are associated with each group or describing the subject matter of each group (Fact 1). Appellant did not identify the claims associated with the elected species in the response to the election of species requirement (Fact 2). In fact, the Examiner canceled certain claims by Examiner's amendment, without any discussion in the record of why certain claims were deemed to correspond to the elected species and others were deemed not to correspond (Fact 3). The Examiner's *ex post facto* explanation of the basis for the restriction presented in the Examiner's Answer is not probative of what Appellant acquiesced to in the election of species during prosecution of the '893 patent.

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[3] Claim 78 is likewise not identical or substantially identical to canceled claims 10-24 and 27-49 of the '499 application.

Given these facts, we are unable to determine the scope of the subject matter that Appellant may have disavowed during prosecution of the '893 patent, and thus we have no basis in the record on which to determine whether the newly-presented claims 13-82, which are different from the canceled claims, are directed to the non-elected species. Given the remedial nature of 35 U.S.C. § 251, we cannot sustain this rejection.

CONCLUSION

Reissue claims 1-82 have not been shown to be based on a reissue oath or declaration that is defective for lack of error correctable under 35 U.S.C. § 251.

DECISION

We REVERSE the Examiner's decision to reject claims 1-82.

REVERSED

nlk

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